REMARKS

I. General

Claims 1-35 were pending in the present application, and all of the pending claims are rejected in the Final Office Action (mailed August 10, 2005). The outstanding issues raised in the Final Office Action are:

- Claims 1-5, 8-22, 24, and 26-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,620,205 issued to Sequeira (hereinafter "*Sequeira*") in view of U.S. Patent No. 6,839,680 issued to Liu et al. (hereinafter "*Liu*");

- Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of U.S. Patent No. 6,834,110 issued to Marconcini et al. (hereinafter "*Marconcini*"); and

- Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of U.S. Patent No. 6,820,133 issued to Grove et al. (hereinafter "*Grove*").

In response to the Final Office Action Applicant filed a Notice of Appeal on October 7, 2005. Instead of filing an appeal brief in furtherance of the appeal, Applicant hereby files, within the two-month time period afforded to Applicant after the filing of the Notice of Appeal, a Request for Continued Examination (RCE) with this accompanying amendment. As set forth below, Applicant respectfully traverses the outstanding claim rejections raised in the Final Office Action, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

II. Amendments

Claims 1, 14, and 22 are amended and new claims 36-37 are added herein. No new matter is presented by the amendments and claim additions presented herein, *see e.g.*, page 5, lines 9-17 of the specification.

III. 35 U.S.C. § 103 Rejections over *Sequeira* in view of *Liu*

Claims 1-5, 8-22, 24, and 26-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu*. Applicant respectfully traverses these rejections as discussed further below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied references must teach or suggest all the claim limitations. Without conceding any other criteria, Applicant respectfully asserts that the rejection is improper as there is insufficient motivation to combine the *Sequeira* and *Liu* references and the applied combination thereof fails to teach or suggest all the claim limitations, as discussed further below.

Independent Claim 1

Independent claim 1 recites:

> A method for content delivery, comprising:
> requesting a piece of content;
> delimiting the piece of content into one or more portions at a source;
> associating an identifier with a selected one of the one or more portions
> of the content, <u>said identifier computed from the selected one of the one or</u>
> <u>more portions of the content</u>;
> sending the identifier to a destination; and
> looking up the identifier at the destination and, if the identifier is
> found, retrieving the associated portion of content at the destination and, if the
> identifier is not found, receiving the associated portion of content from the
> source. (Emphasis added).

A. Applied Combination Fails to Teach or Suggest All Elements of Claim 1

The applied combination of *Sequeira* and *Liu* fails to teach or suggest all the above elements of claim 1. For instance, the combination of *Sequeira* and *Liu* fails to teach or suggest "associating an identifier with a selected one of the one or more portions of the content" where the identifier is computed from the selected one of the one or more portions of the content, as discussed further below.

The Final Office Action appears to assert that because *Sequeira* serves a web page, such web page coded in Hypertext Markup Language (HTML) is delimited into one or more portions at the server before transmission and display by a browser, *see* item 3.1 on pages 2-3 of the Final Office Action. In this regard, the Final Office Action asserts that use of HTML, by its very nature, delimits a web page into one or more portions. HTML is used to create a "source" document for a web page that may contain textual content, image content, links to other documents, etc. The HTML source document contains formatting instructions that are interpretable by a browser to display the web page (e.g., to arrange the textual content, image content, etc. on the screen in a manner defined by the HTML source document).

In general, when a browser executing on a client requests a web page from a web server, the browser is first sent the HTML source document for the requested web page. The HTML source document describes, in a language understandable by the browser, the various elements (e.g., images, etc.) of the web page and an arrangement of such elements (e.g., in which order to display the images, etc. in the web page). The HTML source code includes "tags" that identify the various elements (e.g., image files, etc.) that are to be presented on the web page. The web server also sends the elements (image files, etc.) to the client, and the browser executing on the client displays the elements in the arrangement dictated by the HTML source document.

To the extent that an HTML source document is considered as delimiting content into one or more portions, it does not teach or suggest "associating an identifier with a selected one of the one or more portions of the content" where the identifier is computed from the selected one of the one or more portions of the content. To the extent that a referenced filename (e.g., image file) is included in a HTML source document, for example, such filename is not computed from the content. Indeed, the content of the file may change and the filename remains the same.

Nothing in *Sequeira* or *Liu* teaches or suggests use of an identifier that is computed from a portion of content. Accordingly, the applied combination of *Sequeira* and *Liu* fails to teach or suggest at least the above element of claim 1.

In view of the above, claim 1 is not obvious under 35 U.S.C. § 103(a) over the combination of *Sequeira* and *Liu* because the combination fails to teach or suggest all elements of claim 1.

B. Lack of Motivation to Combine *Sequeira* and *Liu*

Further, the mere fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, *see* M.P.E.P. § 2143.01. Rather, it is well settled that the prior art must suggest the desirability of the claimed invention, *see* M.P.E.P. § 2143.01. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). It is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. *See Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294 (Fed. Cir. 1997).

Here, no motivation exists for combining the teachings of *Sequeira* and *Liu*. First, these references are non-analogous art that are each attempting to solve a different problem. On one hand, *Sequeira* is concerned with receiving web pages and displaying such web pages on a display, such as a television screen. *Sequeira* explains at col. 2, lines 9-14:

> Web pages are designed for displaying on PC monitors, not television sets. Thus, displaying such a page on a television screen generally results in poor image quality and navigating around the page and accessing the hypertext links for a page designed for display on a PC is nearly impossible.

Further, *Sequeira* explains that in a television broadcast environment, bandwidth is too limited for web content and client's associated with broadcast television are generally low-cost clients with limited processing power (CPUs) and limited memory. Thus, *Sequeira* provides a system in which a head-end device processes Internet content received and partitions the content, wherein each partition corresponds to a display (e.g., a television screen).

On the other hand, *Liu* is directed to Internet profiling, wherein Internet activity of users is tracked over time to develop a profile for each user that describes the interests of such user.

No motivation exists for one of ordinary skill in the art to look to these disparate reference teachings. That is, no motivation exists for one of ordinary skill in the art to look to the Internet profiling technique of *Liu* for a cache solution to be utilized in the system of *Sequeira*.

The first Office Action mailed February 9, 2005 asserted that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sequeira to utilize cache technology as taught by Liu … in order to create robust, accurate and maintainable performance techniques for content distribution in network communications." Page 3 of Office Action. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that *Sequeira* can be modified, and does not state any desirability for making the modification. Indeed, no motivation exists for looking to the internet profiling technique of *Liu* for a memory cache to include in *Sequeira*. Further, no motivation exists for using the partition identifiers in *Sequeira* for indexing information stored to a cache, particularly considering that the partition identifiers are not taught or suggested as being used in this way by *Sequeira* and *Liu* does not teach or suggest any usage of partition identifiers.

In response to the above arguments, the Final Office Action asserts on page 5 thereof:

> The test of obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

This fails to address Applicant's arguments. Applicant is not arguing that the test for obviousness is whether a secondary reference may be bodily incorporated into the structure of the primary reference. Nor is Applicant arguing that the references must expressly suggest the claimed invention. Rather, Applicant argues that it is well settled that "There must be

some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). Applicant asserts that no such motivation is found here because the *Sequeira* and *Liu* references are non-analogous art that are each attempting to solve a different problem. No motivation exists for one of ordinary skill in the art to look to these disparate reference teachings. That is, no motivation exists for one of ordinary skill in the art to look to the Internet profiling technique of *Liu* for a cache solution to be utilized in the system of *Sequeira*.

The Final Office Action further asserts on page 5 thereof:

> Furthermore, in response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references.

However, Applicant clearly addresses both *Sequeira* and *Liu* above, and does not attempt to show nonobviousness by attacking the references individually. Rather, Applicant has addressed the teachings of each of the references, and Applicant asserts that the because the teachings are non-analogous art as being directed to different problems, one of ordinary skill in the art would not be motivated to apply the references in the manner suggested by the Final Office Action.

In view of the above, no motivation exists for making the applied combination, and thus the rejection under 35 U.S.C. § 103(a) should be withdrawn for this further reason.

Independent Claim 22

Independent claim 22 recites:

>   An apparatus for delivery of content data comprising:
>   a source having a plurality stored pieces of content, the source for
> receiving requests for content, delimiting the pieces of content into portions,
> <u>computing identifiers from said portions of content, and assigning said</u>
> <u>identifiers to the respective portions of content from which said identifiers are</u>
> <u>computed</u>; and
>   a destination coupled to the source via a network, the destination for
> providing the requests for content, receiving the identifiers from the source in
> response to the requests and looking up the identifiers in a look-up table at the
> destination, and wherein when an identifier is found in the table, the
> destination retrieves an associated portion of content from the table and when
> the identifier is not found in the table, the destination receives the associated
> portion of content from the source via the network. (Emphasis added).

A. Applied Combination Fails to Teach or Suggest All Elements of Claim 22

The applied combination of *Sequeira* and *Liu* fails to teach or suggest all the above

elements of claim 22. For instance, the combination of *Sequeira* and *Liu* fails to teach or

suggest "computing identifiers from said portions of content, and assigning said identifiers to

the respective portions of content from which said identifiers are computed", as discussed

further below.

The Final Office Action relies upon *Sequeira* and HTML source code as teaching

"delimiting the pieces of content into portions". However, as described above with claim 1,

Sequeira and the HTML source code used therein fails to teach or suggest computing

identifiers from portions of content and assigning the identifiers to the respective portions of

content from which they are computed. Further, *Liu* fails to teach or suggest this element of

claim 22. Accordingly, the applied combination of *Sequeira* and *Liu* fails to teach or suggest

at least the above element of claim 22.

In view of the above, claim 22 is not obvious under 35 U.S.C. § 103(a) over the

combination of *Sequeira* and *Liu* because the combination fails to teach or suggest all

elements of claim 22.

B. Lack of Motivation to Combine *Sequeira* and *Liu*

Further, as discussed above with claim 1, insufficient motivation exists for combining the teaching of the system of *Sequeira* for receiving and displaying web pages via a broadcast television environment with the Internet profiling system of *Liu*. Thus, the rejection of claim 22 under 35 U.S.C. § 103(a) should be withdrawn.

<u>Independent Claim 32</u>

Independent claim 32 recites:

> A method for content delivery, comprising:
> requesting a piece of content;
> delimiting the piece of content into one or more portions at a source;
> associating an identifier with a selected one of the one or more portions
> of the content; and
> <u>determining whether to send the selected one or more portions of</u>
> <u>content or the identifier to the destination based on information at the source.</u>
> (Emphasis added).

A. Applied Combination Fails to Teach or Suggest All Elements of Claim 32

The applied combination of *Sequeira* and *Liu* fails to teach or suggest all the above elements of claim 32. For instance, the combination of *Sequeira* and *Liu* fails to teach or suggest "determining whether to send the selected one or more portions of content or the identifier to the destination based on information at the source", as discussed further below.

The Final Office Action treats claims 1 and 32 together on pages 6-7 thereof, and in so doing appears to have addressed only the elements of claim 1. That is, the rejection does not address the "determining whether to send the selected one or more portions of content or the identifier to the destination based on information at the source" recited by claim 32. Even though Applicant raised this argument in response to the first Office Action of February 9, 2005 (*see* page 8 of Applicant's Response mailed May 9, 2005), the Final Office still fails to address the above element of claim 32, but instead appears to treat only the elements of claim 1 in rejecting claim 32.

Neither *Sequeira* nor *Liu* teach or suggest determining whether to send selected one or more portions of content or an identifier to a destination based on information at the source.

For instance, in certain embodiments of the present invention, tag table 112 may be maintained at source 114 for determining whether to send selected one or more portions of content or an identifier to a destination 116. In *Sequeira*, no such determination is made. Rather, a requested web page is sent from web server 104 to head-end 122, which then partitions the web page into display partitions and corresponding partition IDs. No determination is made at the source as to whether to send selected one or more portions of content or an identifier to a destination. Additionally, no portions or identifiers are described in *Liu*, and no such determination is made by *Liu's* system. Thus, the combination of *Sequeira* and *Liu* fails to teach or suggest this further element of claim 32.

In view of the above, claim 32 is not obvious under 35 U.S.C. § 103(a) over the combination of *Sequeira* and *Liu* because the combination fails to teach or suggest all elements of claim 32.

B. Lack of Motivation to Combine *Sequeira* and *Liu*

Further, as discussed above with claim 1, insufficient motivation exists for combining the teaching of the system of *Sequeira* for receiving and displaying web pages via a broadcast television environment with the Internet profiling system of *Liu*. Thus, the rejection of claim 32 under 35 U.S.C. § 103(a) should be withdrawn.

Dependent Claims

In view of the above, Applicant respectfully submits that independent claims 1, 22, and 32 are patentable over the applied combination of *Sequeira* and *Liu*. Further, each of dependent claims 2-5, 8-21, 24, 26-31, and 33-35 depend either directly or indirectly from one of independent claims 1, 22, and 32, and thus inherit all limitations of the respective independent claim from which they depend. It is respectfully submitted that dependent claims 2-5, 8-21, 24, 26-31, and 33-35 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

IV. 35 U.S.C. § 103 Rejections over *Sequeira* in view of *Liu* and *Marconcini*

Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of *Marconcini*. Claims 6 and 7 each depend either directly or indirectly from independent claim 1, and thus inherit all limitations of independent claim 1. As discussed above, Applicant respectfully submits that independent claim 1 is patentable over the rejection of record. *Marconcini* fails to correct the above-identified deficiencies in the rejection of claim 1. Thus, it is respectfully submitted that dependent claims 6-7 are allowable not only because of their dependency from independent claim 1 for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of claim 1 from which they depend).

V. 35 U.S.C. § 103 Rejections over *Sequeira* in view of *Liu* and *Grove*

Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of *Grove*. Claims 23-25 each depend either directly or indirectly from independent claim 22, and thus inherit all limitations of independent claim 22. As discussed above, Applicant respectfully submits that independent claim 22 is patentable over the rejection of record. *Grove* fails to correct the above-identified deficiencies in the rejection of claim 22. Thus, it is respectfully submitted that dependent claims 23-25 are allowable not only because of their dependency from independent claim 22 for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of claim 22 from which they depend).

VI. New Claims

New claims 36-37 are added herein. Claims 36-37 each depend either directly or indirectly from independent claim 32, and thus inherit all limitations of independent claim 32. As discussed above, Applicant respectfully submits that independent claim 32 is patentable over the rejection of record. Thus, it is respectfully submitted that dependent claims 36-37 are allowable not only because of their dependency from independent claim 32 for the reasons discussed above, but also in view of their novel claim features (which both narrow

the scope of the particular claims and compel a broader interpretation of claim 32 from which they depend).

V. Conclusion

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

The required fee for this response is enclosed. If any additional fee is due, please charge Deposit Account No. 08-2025, under Order No. 10016145-1 from which the undersigned is authorized to draw.

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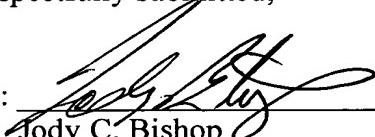
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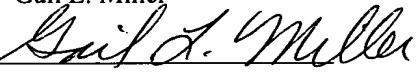
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